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Attorney Docket No. ITW7510.073

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Albrecht et al.
Serial No. : 10/707,214
Filed : November 26, 2003
For : WELDING STUD
Group Art No. : 3677
Examiner : William L. Miller

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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**PETITION UNDER 37 C.F.R. §1.144 SEEKING SUPERVISORY REVIEW OF
RESTRICTION REQUIREMENT**

Dear Sir:

Responsive to the Restriction Requirement mailed May 15, 2007, Applicant requests supervisory review and consideration of the following remarks in support of the rejoinder of withdrawn claims 18-24.

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REMARKS

In the Restriction Requirement mailed May 15, 2007, the Examiner imposed a restriction on claims 1-29 and identified two 'inventions' in the pending claims. The Examiner's classification of the 'inventions' included Group I consisting of claims 1-17 and 25-29 drawn to a welding stud and classified by the Examiner in class 411, and Group II consisting of claims 18-24 drawn to a method of manufacturing and classified by the Examiner in class 470.

In response, Applicant filed a timely Election and Response on June 15, 2007, in which alleged Invention I was elected with traverse, as deemed drawn to claims 1-17 and 25-29. Despite Applicant's arguments, the Examiner made the Restriction final, and withdrew claims 18-24 from consideration in a 2nd Restriction Requirement mailed September 18, 2007. In that 2nd Restriction Requirement, the Examiner also further restricted the elected Invention I by identifying Species I-V therein, the substance of which is not addressed in this petition, but is traversed in a Reply to the Examiner.

Initially, it is noted that this application has been pending for four (4) years, and during that time has had four (4) substantive Office Actions, two (2) Advisory Actions, and two (2) RCE's. Now, in the course of the last several months, this application has now had two (2) Restriction Requirements, the first being traversed and which is now the subject of this Petition for Supervisory Review. The fact that this application has already been extensively examined shows that there is no serious burden on the examiner requiring restriction. It is also noted that the current restrictions are inconsistent with "RCE" practice in that in a "Request for Continued Examination," Applicant is entitled to continued examination, not examination anew. Regardless, Applicant believes that the restriction imposed by the Examiner between Inventions I and II is improper, as set forth here below.

In the Restriction of May 15, 2007, the Examiner related Inventions I and II as process of making and product made. *Office Action*, May 15, 2007, p. 2. A product made and a process for making the product can be shown to be distinct inventions if the product "can be made by another and materially different process..." or if "the process as claimed is not an obvious process of making the product and the process as claimed can be used to make another materially different product." *MPEP §806.05(f)*. In making the restriction, the Examiner stated that the product of

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Invention I can be made by another and materially different process other than that set forth in Invention II because "the product can be made from casting instead of stamping or etching." *Office Action*, supra at 2. Additionally, the Examiner stated that the process as claimed can be used to make another and materially different product because "the process can be used for making products other than a weld stud, such as a set-screw." *Id.*

Responsive thereto, Applicant argued that the Examiner disregarded that which is called for in the claims with respect to the alleged "inventions." That is, Applicant argued that, absent from Invention II, is any requirement that the welding stud called for therein be formed by etching or stamping, as the Examiner asserted. Additionally, Applicant argued that Invention II specifically calls for a plurality of steps for forming a welding stud, and as such, it is unclear how such steps can be used to make another materially different product, such as a set screw.

In the 2nd Restriction Requirement of September 18, 2007, the Examiner dismissed Applicant's arguments and maintained the Restriction, again stating that "the grooves in the second end of the stud could be formed via casting as opposed to etching or machining as claimed by the applicant (see claims 21-22)." *Restriction Requirement*, September 18, 2007, p. 2. Not only did the Examiner dismiss Applicant's prior arguments, but the Examiner also seems to have misconstrued those arguments, by stating that "the Examiner is required to meet only one (not both) of the above two conditions," *id.* (relating to the requirements under §MPEP 806.05(f)). Applicant recognizes that only one of the requirements of MPEP §806.05(f) need be shown, that being either that the product can be made by another and materially different process or that the process as claimed can be used to make another and materially different product. However, as set forth in detail here-in-below, Applicant believes that the Examiner has failed to show either of these two requirements, and in maintaining the restriction, has continued to mischaracterize the limitations of Invention II.

As set forth above, the Examiner stated that the product of Invention I can be made by another and materially different process other than that set forth in Invention II because "the product can be made from casting instead of stamping or etching." Applicant respectfully disagrees. That is, Applicant believes that the Examiner has failed to show that the product as claimed in Invention I can be made by another materially different process. As called for in Invention I, a welding stud comprises a body having a first and second end, the first end to

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engage a stud welding gun and the second end being a weld end. The process of Invention II calls for providing a welding stud having a first end and a second end, forming the first end to engage a stud welder, and forming the second end to be entirely welded to a workpiece and with increased resistance to current flow through the second end in the area between a perimeter and a central area of the second end as compared to a welding stud having a nipple and a generally planar surface thereabout. Absent from Invention II, however, is any requirement that the welding stud called for therein be formed by etching or stamping, as the Examiner has asserted. Invention II, as set forth in independent claim 18, does not call for a limitation as to the exact method for forming the welding stud. As such, the process of Invention II, as called for in claim 18, could cover stamping, etching, and casting processes. The Examiner's asserted limitations applied to Invention II, for requiring formation of the welding stud to be achieved via etching or machining, are only set forth in dependent claims 21 and 22, respectively, and any application of such limitations into independent claim 18 for purposes of restriction is clearly improper.

In light of the above, the Examiner has failed to show that the product of Invention I can be made from a materially different process than that of Invention II. That is, the Examiner has failed to show that the process of Invention II requires etching or stamping to form the welding stud of Invention I, and that the process of Invention II could not also cover a casting process.

The Examiner also stated that "the process [of Invention II] can be used for making products other than a weld stud, such as a set-screw." *Office Action*, May 15, 2007, p. 2. Applicant respectfully disagrees. Specifically, Applicant believes that the Examiner has failed to show that "the process as claimed can be used to make another materially different product" as set forth in MPEP §806.05(f).

The Examiner's assertion that the process of Invention II can be used to make other products, "such as a set screw," *Id.*, fails to show that Invention II can be used to make another materially different product. Invention II calls for the steps of providing a welding stud, forming the first end to engage a stud welder, and forming the second end to be entirely welded to a workpiece and with increased resistance to current flow. As Invention II specifically calls for the steps of providing and forming a welding stud, it is unclear how these steps can be used to make another materially different product, such as a set screw. Thus, the Examiner's assertion fails to show that "Invention II" can be used to make another materially different product.

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As such, for at least these reasons, the Examiner has failed to show that Inventions I and II are distinct. Therefore, a restriction under MPEP 806.05(f) between Inventions I and II has not been shown, and rejoinder of Inventions I and II is required.

Applicant appreciates the Director's consideration of these Remarks and cordially invites the Director to call the undersigned, should the Director desire discussion.

Respectfully submitted,

/Timothy J. Ziolkowski/

Timothy J. Ziolkowski
Registration No. 38,368
Phone 262-268-8100
tjz@zpspatents.com

Respectfully submitted,

/Kevin R. Rosin/

Kevin R. Rosin
Registration No. 55,584
Phone 262-268-8100 ext. 15
krr@zpspatents.com

Dated: October 18, 2007
Attorney Docket No.: ITW7510.073

P.O. ADDRESS:
Ziolkowski Patent Solutions Group, SC
136 South Wisconsin Street
Port Washington, WI 53074
262-268-8100

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General Authorization and Extension of Time

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-2623. Should no proper payment be enclosed herewith, as by credit card authorization being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-2623. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extensions under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-2623. Please consider this a general authorization to charge any fee that is due in this case, if not otherwise timely paid, to Deposit Account No. 50-2623.

/Timothy J. Ziolkowski/

Timothy J. Ziolkowski
Registration No. 38,368
Direct Dial 262-268-8181
tjz@zpspatents.com

Dated: October 18, 2007
Attorney Docket No.: ITW7510.073

P.O. ADDRESS:
Ziolkowski Patent Solutions Group, SC
136 South Wisconsin Street
Port Washington, WI 53074
262-268-8100